

Germany

Protection of country names

1. Legal basis concerning the protection of country names in the field of registration of trade marks

The legal basis for excluding country names from registration as trade marks in the Federal Republic of Germany is Section 8 (2), nos. 1, 2 and 4 Trade Mark Act.

Pursuant to Section 8 (2), no. 2 Trade Mark Act, signs which consist exclusively of signs or indications which may serve to designate the geographical origin of the goods or the services shall be excluded from registration in the trade mark register.

As a rule, these signs are also devoid of any distinctive character, which consequently means that they cannot be registered because registration would conflict with the ground for refusal of Section 8 (2), no.1 Trade Mark Act.

Furthermore, in accordance with Section 8 (2), no. 4 Trade Mark Act, signs are also excluded from registration if they are of such a nature to deceive the public, in particular with regard to the geographical origin of the goods or services.

2. Applicable procedures

Since the "Chiemsee" – judgment of the ECJ (cases C-108/97 and C-109/97) of 4 May 1999 (GRUR [*Gewerblicher Rechtsschutz und Urheberrecht – industrial property protection and copyright*] 1999, 723) names designating a geographical origin – for example names of countries – as a rule must be kept available for use by other traders. Any registrations of country names in the trade mark German register usually date from a time before that judgment.

A geographical name may be registered as a trade mark only if there is special evidence that, exceptionally, it is not capable of serving in trade as a reference to the geographical origin of the goods and services concerned. In this context, it is not only the current need to leave the sign free for use by others that should be considered but, based on a realistic prediction, it should also be considered whether it is reasonable to assume that such a need may be expected in the future (BGH [*Bundesgerichtshof – Federal Court of Justice*] - I ZB 10/01 of 17 July 2003 - *Lichtenstein*; I ZB 53/05 of 13 March 2008 (nos. 12, 18, 23) - *SPA II*; - I ZB 107/08 of 20 May 2009 (no. 15) – *Vierlinden*).

With regard to a decision to be taken on the basis of the prediction, the need to leave a sign free for use by other traders should, as a general rule, apply to country names. The prediction that the name of a country is not capable of serving as a present or future indication of origin for the goods and services in question can hardly be made solely on the basis of the size of the territory and the importance of a country. Thus the court confirmed the rejections of the names of the US states "California" (BPatG [*Bundespatentgericht – Federal Patent Court*] 24 W (pat) 120/98 of 20 July 1999 and 26 W (pat) 26/12 of 18 April 2012) and "Dakota" (BPatG 24 W (pat) 71/ 02 of 18 November 2003) and the name of the geographical region "Sibirien" (BPatG 26 W (pat) 31/12 of 4 July 2012).

3. Scope of protection

As set out in item 2, geographical names (e.g. country names) will only be registered, if there is no descriptive relationship to the goods and services for which registration is sought. If the country name constitutes only a part of the sign applied for, it must be examined whether other elements of the trade mark (words or image) have sufficient distinctiveness to overcome the inability to be protected applying to the country name. However, the scope of protection of the trade mark is restricted to those elements on which protection is based.

4. Protection is granted for the official name of the country only or also for variations of those names

In the Federal Republic of Germany protection is not only granted for official names of countries but, to some extent, also for variations and abbreviations.

The protection of variations of country names depends on whether these names are suitable to describe the goods and services claimed and whether they will be recognised by the relevant section of the German public. As a rule, the mentioned grounds for refusal are also applicable to commonly used variations of names and abbreviations and – depending on the context – to adjectives too.